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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,240	03/28/2002	Kazuhiko Ooga	Q63840	4544

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/089,240

Applicant(s)

OOGA ET AL.

Examiner

Tatyana Zalukaeva

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Trapasso et al (U.S. 5,498,751) or Rosenquist (U.S. 4,701,516).

Trapasso discloses a product obtained by transesterification, and a transesterification method comprising transesterifying the esters of carboxylic acids with 1,2- and 1,3- polyols selected from araalkyl polyols (claim 1). When transesterification occurs, not only aromatic polyols, but aromatic alcohols can be used for transesterification (claim 31, 61). In all cases transesterification occurs in the presence of organotin compounds (abstract, claim 38). Benzyl alcohol is clearly named

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as an alcohol for transesterification in claim 62, line 4 of col. 20. The carboxylic acid is selected from mono-d- and tricarboxylic acids, wherein benzene tricarboxylic acid is named in col. 20, line 16, and allyl and methallyl alcohol used for esterification is named in col. 20, line 11.

Rosenquist discloses esters of trimellitic (benzene tricarboxylic acid). Such Example 1 describes a procedure, wherein reaction vessel there is charged equimolar proportions of trimellitic anhydride and benzyl alcohol in methyl isobutyl ketone. The charge is heated to reflux temperature (circa 150.degree. C.) for about 60 minutes. At the end of this time period an aliquot of the reaction mixture shows an absence of anhydride by infra-red analysis. The solvent is removed under vacuum to obtain a white powder which is the benzyl ester of 1,2,4-benzene tricarboxylic acid (infrared absorption at 1735 cm.<sup>sup.</sup>-1 and 1705 cm.<sup>sup.</sup>-1). Preparation 2, wherein the procedure of Example 1 is repeated except that the benzyl alcohol as used therein is replaced with an equal proportion of **allyl alcohol**, neopentyl alcohol, isopropyl alcohol, cyclohexanol, or 4-tert-butylcyclohexanol, respectively, to obtain the corresponding ester of 1,2,4-benzene tricarboxylic acid. (see col. 8, lines 53-68, col. 9, lines 1, 2).

3. Claims 1, 3, 4, 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ooga et al (U.S. 6,545,120).

Ooga discloses alicyclic (meth)allyl ester compound for plastic lenses, which can be obtained by a simple and easy production transesterification process and which can endure a long-term storage (abstract). Trimethallyl cyclohexane tricarboxylate, and

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tetracarboxylate, for example, are disclosed in col.5, lines 4-10. Transestrification catalysts are described in col.5, 20-55, and are within the scope of the instant claims. The [plastic lens composition described by Ooga may contain radical initiator, comprising peroxydicarbonates listed in col.15, lines 1-7, such initiators are added in the amount of 0.1-10 parts by mass. The viscosity of the plastic lens composition of Ooga is generally in the range from 10 to 10,000 mPas, more preferably from 10 to 500 mPas.(col.14, lines 33-37). The plastic resin obtained by curing the plastic lens composition of the invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1,5,and 6 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over OOGA in view of US 6,586,508 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was

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made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

U. S. 6,586,508 recognizes the equivalency for transesterification of organotin compounds and sulfonic, sulfuric and hydrochloric acids, as described by claims 5 and 6. In the instant case substitution of equivalent compounds as catalysts in similar processes requires no express motivation, as long as the prior art recognizes equivalency, In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. V. Linde Air products Co. 85 USPQ 328 (USSC 1950).

9. Other prior art cited in PTOL-892 shows the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 305-2450. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

September 11, 2003

  
TATYANA ZALUKAEVA  
PRIMARY EXAMINER